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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/446,328	04/17/2000	ULRICH SPECK	SCH1653	2161

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EXAMINER

HARTLEY, MICHAEL G

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 02/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application N .

09/446,328

Applicant(s)

SPECK ET AL.

Examin r

Michael G. Hartley

Art Unit

1616

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 February 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 10 February 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☒ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

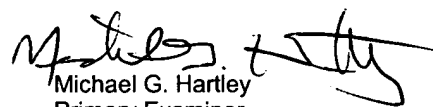
Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 18-45.

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____


Michael G. Hartley
Primary Examiner
Art Unit: 1616

Continuation of 5. does NOT place the application in condition for allowance because: 112 rejection: there is nothing to show that applicant envisioned the exclusion of a polymer, peptide, etc. iodine containing contrast agent at the time of filing, as there is nothing to show that such exclusion of such contrast agents had basis in the original disclosure, as required. 102 rejection: the arguments and declaration are not persuasive because a rejection under 35 USC 102 does not require "use" but only that the invention is described in a patent. Galkin discloses a method of X-ray mammography in which contrast agents should be administered (column 4, lines 44-56). Thus, nothing is missing from the disclosure of Galkin. Anticipation does not require the disclosure to be in the examples section of a patent. With regards to the declaration, whether or not such a method was performed, i.e., used, is not relevant, as anticipation only requires that the invention has been described. 103 rejection: the number of references is not relevant for rebutting a rejection under 35 USC 102, and the number of references was only required to provide a teaching to show that the various contrast agents in the claims are well known. Nitecki is specifically drawn to new X-ray contrast agents and teaches that the use of the contrast agents is for limited imaging applications, namely "Another possible use involves...e.g., by inflammations or by tumor, as well as use in lymphography and mammography". Such a limited number of uses of the disclosed contrast agents clearly provide a teaching that the contrast agents may be used in X-ray mammography (i.e., projection mammography). A prior art reference may be relied on for all that it teaches. With regard to the declaration, the fact that such methods have not been performed to the best of the declarants knowledge, fails to contradict that such a method has been described by both Galkin and Nitecki.